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Paper No. 25
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Modern Italian Bakery of West Babylon, Inc.

Serial No. 74/375,061

Patricia A. Wilczynski of Scully, Scott, Murphy & Presser for Modern Italian Bakery of West Babylon, Inc.

Kimberly N. Reddick, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Hanak, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Modern Italian Bakery of West Babylon, Inc. has filed an application to register the mark MODERN and design, in the format depicted below, for "bread, rolls and bagels."[1]

[1] Serial No. 74/375,061, filed April 1, 1993, claiming first use dates of 1959.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the registered mark LA MODERNA for "macaroni, pasta, spaghetti, cookies and crackers."[2] The final refusal has been appealed and both applicant and the Examining Attorney have filed briefs.[3] An oral hearing was not requested.[4]

We make our determination of likelihood of confusion on the basis of those of the *du Pont* factors[5] which are relevant under the circumstances at hand and for which evidence is of record. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See In re Azteca Restaurant Enterprises,

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[2] Registration No. 1,828,454, issued March 29, 1994, Section 8 & 15 affidavits accepted and acknowledged, respectively. The term LA MODERNA has been translated as "the modern."

[3] Although the prior Examining Attorney had also cited a second registration belonging to the same entity, the reliance upon this registration (Reg. No. 1,605,821) was withdrawn by the newly assigned Examining Attorney in her brief.

[4] Applicant requested in its reply brief that decision be suspended in view of the apparent failure of the registrant to timely file a Section 8 affidavit for Registration No. 1,828,454. This request is moot, however, in that a Section 8 affidavit was filed by applicant within the 6 month grace period and has been accepted by the Office. See Section 8(c)(1) of the Trademark Act.

[5] See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Insofar as the respective marks are concerned, the Examining Attorney maintains that applicant's mark is not only similar to registrant's mark in appearance and sound, but also in meaning or connotation. Relying upon the doctrine of foreign equivalents, the Examining Attorney argues that literal portion of applicant's mark MODERN is the equivalent in connotation to registrant's mark LA MODERNA, which translates to "the modern." Thus, she argues, the marks as a whole evoke the same commercial impression.

Applicant, on the other hand, contends that the marks are neither phonetically nor visually similar in view of the extra letters and words in registrant's mark and of a design element in applicant's mark. Applicant further argues that although LA MODERNA translates to "modern," the term LA MODERNA would connote an Italian, Spanish, or Mexican origin for the foods with which it is being used, whereas applicant's mark would create a much different commercial impression.

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English in determining similarity of meaning and connotation for

purposes of likelihood of confusion. However, even if the non-English word and its English counterpart have a similar meaning and connotation, this is only one prong of the sight, sound, and meaning trilogy of analysis. Thus, similarity in meaning may be outweighed by differences in appearance, sound or other factors in reaching the final conclusion on likelihood of confusion. See J. T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 23:36-37 (2000); In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983).

Here there is no question but that the English translation of registrant's mark LA MODERNA is "the modern," which would likely be shortened to "modern."[6] Considering the relatively large portion of the United States population which is familiar with Spanish, it is reasonable to assume that an appreciable segment of the population would readily translate registrant's mark. But even if unfamiliar with Spanish, LA MODERNA is so similar to the English word "modern" that many purchasers would attach such a connotation to the mark. See In re American

[6] We do not consider the article "the" to be required in translating the Spanish term into the equivalent English term. See In re Hub Distributing, Inc., 218 USPQ 284, 285 fn. 1 (TTAB 1983)("Sun" the equivalent of EL SOL).

Safety Razor Co., 2 USPQ2d 1459 (TTAB 1987)(BUENOS DIAS viewed as the equivalent of GOOD MORNING).

Moreover, there are no significant differences in these marks with respect to appearance or sound. The major visual impact of registrant's mark is the word MODERNA and of applicant's mark is the word MODERN. The commonplace oval background used by applicant is clearly of minimal visual significance in the mark as a whole. The sound of the two marks is also highly similar, one admittedly having a foreign cast, but nonetheless being close to the English term "modern."

The only other issue is whether the marks as a whole create different commercial impressions, when used on the particular goods of applicant and registrant. Applicant insists that since registrant is using its foreign language mark with goods such as macaroni, pasta, spaghetti, cookies and crackers, the mark evokes a suggestion of goods of an ethnic or international nature. Applicant's mark is said to create a much different commercial impression.

We cannot find a viable basis for making such a distinction. In the first place, registrant's mark is in Spanish and the only "ethnic"-type goods on which the mark is being used are Italian in nature. Furthermore, applicant is also using its mark with goods which may be

considered “ethnic” in nature. We note particularly the specimen of record showing use of applicant’s mark on Italian bread. We are convinced that the overall commercial impressions created by the two marks LA MODERNA and MODERN, as used on the identified goods, would be highly similar.

Turning to the goods, the Examining Attorney argues that the respective food items are closely related, relying mainly on the “cookies and crackers” of the registration in comparison with applicant’s “bread, rolls, and bagels.” As support for this position, the Examining Attorney refers to copies of several third-party registrations earlier made of record showing registration by a single entity of the same mark for both cookies or crackers and bread, rolls or bagels.

Applicant insists that the goods are distinguishable on the basis that registrant’s goods are “durable” foods whereas applicant’s “fresh baked goods” are perishable in nature. Applicant also argues that the goods travel in different channels of trade, in view of this distinction between perishable bakery goods and durable foodstuffs.

As a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and registration. Canadian

Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). It is not necessary that the goods be similar or even competitive to support a holding of likelihood of confusion; it is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. If there are no restrictions in the application or registration as to the channels of trade, the goods must be assumed to travel in all the normal channels of trade for goods of this nature. See Kangol v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

There are no restrictions in applicant’s application limiting its bake goods to “fresh” or highly “perishable” products. In fact, as pointed out by the Examining Attorney, one of the specimens of record shows use of applicant’s mark on frozen bread. Even though applicant argues that such a product would still have a short shelf life, we cannot see how applicant’s baked goods can be

distinguished from the cookies of registrant, which could be sold in a packaged form with an equally short shelf life.

Similarly, there is no limitation in applicant's application to any particular channels of trade, such as independent bakeries as opposed to general food stores. Neither does the fact that certain of registrant's goods may be "ethnic" in nature in any way limit registrant's channels of trade. Obviously, products such as cookies and crackers, as well as pasta and macaroni, may be sold in the same retail stores to the same purchasers as the bakery products of applicant.

Moreover, not only would the respective goods be likely to be sold in the same retail outlets, but there is a close relationship between baked goods such as bread, rolls and bagels and baked goods such as cookies and crackers. The third-party registrations introduced by the Examining Attorney are fully adequate to show that these are the types of foods products which may emanate from the same source. See In re Albert Trostel & Sons Co, *supra*; In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988). Thus, when the highly similar marks involved herein are used on the respective baked goods, purchasers may well assume a common source. While applicant insist that we must take

into consideration the entire description of registrant's goods in making this comparison, this is not the case. Likelihood of confusion may be found if the public would be likely to believe that applicant's goods originate from the same source as any of the goods recited in the registration. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 208 USPQ 987 (CCPA 1981).

Finally, applicant raises the issue of lack of actual confusion, despite the marks coexistence on the market for almost fifteen years. This factor can be given little weight, however, because registrant has not had the opportunity to be heard from on this point.[7] See In re National Novice Hockey League, Inc., 222 USPQ 638 (TTAB 1984). In addition, as has often been stated, the test under Section 2(d) is likelihood of confusion, not actual confusion. See Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Although applicant attributes the "peaceful concurrent use" to the fact that applicant and registrant use different color combinations in their packaging, this is not a factor which can be taken into consideration in

[7] We would note that although examination was suspended for a period of time in order for applicant to obtain a consent agreement from registrant, such a consent was never forthcoming.

making our determination of likelihood of confusion. While trade dress may provide evidence that a word mark projects a confusingly similar commercial impression, the opposite is not true, since trade dress may be changed at any time. See Speciality Brands, Inc. v. Coffee Bean Distributors, inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984). The differences in the present-day trade dress of applicant and registrant cannot be relied upon to obviate a likelihood of confusion.

Accordingly, upon weighing all the relevant *du Pont* factors, we find confusion likely.

Decision: The refusal to register under Section 2(d) is affirmed.